

REMARKS

Applicant has carefully studied the Office Action of April 5, 2004 and offers the following remarks thereto.

Claims 1, 2, and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over Corbett et al. (hereinafter "Corbett") in view of Rogers et al. (hereinafter "Rogers"). Applicant respectfully traverses. When the Patent Office combines references in an obviousness analysis, the Patent Office must do two things. First, the Patent Office must identify a motivation to combine the references. Second, the Patent Office must support this motivation with actual evidence. *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). As a separate analysis, if the Patent Office wishes to modify a combination, the Patent Office must provide a second motivation and more actual evidence to support this second motivation. *Id.* Even if the combination is proper, for the Patent Office to establish *prima facie* obviousness, the Patent Office must show where in the combination of references each and every claim element is located. MPEP § 2143.03.

In the analysis of claim 1, the Patent Office combines Corbett with Rogers. Specifically, the Patent Office opines that Corbett teaches all the elements except that the voice data consists of Internet protocol voice data packets and relies on Rogers to fill the missing element. The Patent Office opines that it would be obvious to modify Corbett with the internet protocol voice data packets taught by Rogers to allow "for a system that processes various types of calls as suggested by Rogers." Applicant traverses this analysis on multiple grounds. Initially, the Patent Office is not entitled to extract selective portions of a reference. MPEP § 2141.02. The Patent Office is apparently excising a single line from Rogers and modifying Corbett to include this single line. This is impermissible.

Applicant proceeds as if the Patent Office had combined the references and then proposed to modify the combination, as this is the proper approach in an obviousness analysis. Under the proper analysis, Applicant notes that the Patent Office has not provided actual evidence to support the motivation to combine the references. Specifically, there is no evidence that it is desirable to process various types of calls. Absent such evidence, the combination is improper. Even if the combination is proper, the combination must still be modified to allow the caller ID functionality of Corbett on an IP based call. The Patent Office has not provided any motivation to support such a modification, nor has the Patent Office provided any actual

evidence to support such a modification. Since the Patent Office has not done so, the combination, if proper, cannot be modified and does not show the claimed invention. To this extent, the Patent Office has not made a proper rejection and the claims are allowable.

Even if the Patent Office's approach in this case is proper, the motivation does not compel the end result. The Patent Office's propounded motivation is to allow for various types of calls. Corbett already processes various types of calls. Specifically, Corbett processes "tip and ring" calls, ISDN calls, and video calls (see col. 5, line 38, col. 5, line 40, and col. 7, lines 33-34 respectively). If the motivation is to process various types of calls, Corbett already does this, and thus, there is no motivation to seek another reference. Since there is no motivation to combine the references, the combination is improper and the references individually do not teach or suggest all the claim elements. Since the references individually do not teach or suggest all the claim elements, the Patent Office has not established obviousness, and the claims are allowable.

Even if the combination is proper in the manner that the Patent Office advances, the combination still does not establish *prima facie* obviousness, because the combination does not show all the claim elements.

Claim 1 recites five elements: a client terminal, a graphical display, a client terminal controller, a terminal proxy server, and a graphical user interface. Within Corbett, the Patent Office identifies the telephone of col. 4, line 15 as the client terminal; the television 12 as the graphical display; the remote control 54 as the client terminal controller; the video caller ID circuit 10 as the terminal proxy server; and video phone 44 as the graphical user interface. Applicant verbally confirmed this with the Examiner during the telephonic conversation of June 24, 2004. If the Patent Office, upon reconsideration, feels that this understanding is incorrect, Applicant requests clarification and the opportunity to address such a clarification in a future response.

The first problem with this interpretation of the reference is that the remote control 54 does not control the unlabeled telephone. Specifically, claim 1 recites that the client terminal controller controls the client terminal. The Patent Office indicates that the remote control 54 is the client terminal controller and that the telephone of col. 4, line 15 is the client terminal. Thus, to meet the language, the remote control must control the telephone of col. 4, line 15. However, the remote control does not control the telephone of col. 4, line 15. Rather, the remote control

has no relation to the telephone of col. 4, line 15 and cannot control the telephone of col. 4, line 15. To this extent, the element identified by the Patent Office as the client terminal controller does not teach or suggest the claim element for which it is cited.

The second problem with this interpretation is that the video caller ID circuit 10 does not send synchronized signals to the telephone of col. 4, line 15 and the remote control 54.

Specifically, claim 1 recites that the terminal proxy server sends synchronized signals to the client terminal and the client terminal controller. Under the Patent Office's construction, the video caller ID circuit 10 is the terminal proxy server. Thus, to meet the claim language, the video caller ID circuit 10 must send synchronized signals to the telephone of col. 4, line 15 and the remote control 54. There is nothing that indicates that the video caller ID circuit 10 sends a signal to the telephone at all. For example, in Figures 1-4, no telephone is present anywhere in the Figures. The output of the video caller ID circuit 10 goes to the television, not to a phone. In essence, the video caller ID circuit 10 uses a telephone jack to know that there is an incoming call, but does not communicate this knowledge to a telephone because the telephones independently receive that information from another telephone jack. Likewise, the video caller ID circuit 10 never sends any information to the remote control 54. While the called party can use the remote control 54 to direct the call to various locations such as voice mail, there is no indication that the remote control 54 has any intelligence or processing power to receive an indication that there is an incoming call. To this extent, the reference does not teach that the client terminal and the client terminal controller receive the synchronized signals as recited in the claim.

The third problem is that the remote control 54 does not retrieve information about the incoming caller and convey the information to the client terminal user on the graphical display. Claim 1 recites that the client terminal controller retrieves information about the incoming call in response to the synchronized signal. The Patent Office has identified the remote control 54 as the client terminal controller. However, the remote control 54 does not retrieve the information about the incoming call. Rather, Corbett explains that the video caller ID circuit 10 extracts the caller ID information from the incoming ring tone and formats for presentation on the television, but nowhere is there any teaching or suggestion that the remote control 54 retrieves information about the incoming caller.

Thus, Corbett does not teach or suggest several of the elements for which it is cited. Nothing in Rogers cures the deficiencies of Corbett. Since the references individually do not teach or suggest the claim elements, the combination of references does not teach or suggest all the claim elements, and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, the claims are allowable.

Applicant appreciates the telephone conversation with Examiner on June 24, 2004 when Corbett was discussed, and particularly Applicant requested clarification from the Examiner as to what element was the terminal proxy server. The Examiner indicated that the component that sends the ring signal to the telephone and the television is the terminal proxy server. While this would closely mirror the claim language, Applicant is unable to find such an element. As explained during the telephonic interview, the circuit 10 sends the signal to the television, but does not send a synchronized signal to the telephone. Likewise, the central office, which sends a ring signal to the telephone does not send a synchronized signal to the television. The Examiner indicated an initial agreement with this position. Applicant herein presents the argument in written form so that the Patent Office may evaluate the argument in a more structured form. If the Patent Office wishes to clarify the element that is the terminal proxy server, Applicant reserves the right to address such a clarifying explanation in a future response.

Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the Patent Office has not established *prima facie* obviousness for the claim, and Applicant requests withdrawal of the § 103 rejection of claim 1 at this time.

Claims 2 and 9 depend from claim 1 and are allowable for at least the same reasons. Applicant requests withdrawal of the § 103 rejection thereof at this time.

Claim 3 was rejected under 35 U.S.C. § 103 as being unpatentable over Corbett in view of Rogers and further in view of Koralewski et al. (hereinafter "Koralewski"). The standard for obviousness is set forth above.

Applicant initially traverses the rejection on the basis that the Patent Office has not provided the requisite actual evidence to support the combination of Corbett and Rogers, much less the combination of Corbett, Rogers, and Koralewski. Absent such actual evidence, the combination is improper, and the claim is allowable.

Applicant further traverses on the basis that nothing in Koralewski cures the deficiencies of the underlying combination of Corbett and Rogers. Since the references individually do not teach or suggest the claim elements, the combination of references does not teach or suggest the claim elements, and the Patent Office has not established obviousness.

Claim 4 was rejected under 35 U.S.C. § 103 as being unpatentable over Corbett and Rogers in view of Danne '381. Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection on the basis that the Patent Office has not provided the requisite actual evidence to support the combination of Corbett and Rogers, much less the combination of Corbett, Rogers, and Danne '381. Absent such actual evidence, the combination is improper and the claim is allowable.

Applicant further traverses on the basis that nothing in Danne '381 cures the deficiencies of the underlying combination of Corbett and Rogers. Since the references individually do not teach or suggest the claim elements, the combination of references does not teach or suggest the claim elements, and the Patent Office has not established obviousness.

Claim 5 was rejected under 35 U.S.C. § 103 as being unpatentable over Corbett and Rogers, Koralewski, and Danne and further in view of Ranalli et al. (hereinafter "Ranalli"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection on the basis that the Patent Office has not provided the requisite actual evidence to support the combination of Corbett, Rogers, and Koralewski, much less the combination of Corbett, Rogers, Koralewski, and Danne. Absent such actual evidence, the combination is improper, and the claim is allowable.

Applicant further traverses on the basis that nothing in Danne cures the deficiencies of the underlying combination of Corbett, Rogers, and Koralewski. Since the references individually do not teach or suggest the claim elements, the combination of references does not teach or suggest the claim elements, and the Patent Office has not established obviousness.

Claim 6 was rejected under 35 U.S.C. § 103 as being unpatentable over Corbett in view of Rogers in view of Gallant et al. (hereinafter "Gallant"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection on the basis that the Patent Office has not provided the requisite actual evidence to support the combination of Corbett and Rogers, much

less the combination of Corbett, Rogers, and Gallant. Absent such actual evidence, the combination is improper and the claim is allowable.

Applicant further traverses on the basis that nothing in Gallant cures the deficiencies of the underlying combination of Corbett and Rogers. Since the references individually do not teach or suggest the claim elements, the combination of references does not teach or suggest the claim elements, and the Patent Office has not established obviousness.

Claims 7 and 8 were rejected under 35 U.S.C. § 103 as being unpatentable over Corbett in view of Rogers in view of Tidwell et al. (hereinafter "Tidwell"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection on the basis that the Patent Office has not provided the requisite actual evidence to support the combination of Corbett and Rogers, much less the combination of Corbett, Rogers, and Tidwell. Absent such actual evidence, the combination is improper, and the claim is allowable.

Applicant further traverses on the basis that nothing in Tidwell cures the deficiencies of the underlying combination of Corbett and Rogers. Since the references individually do not teach or suggest the claim elements, the combination of references does not teach or suggest the claim elements, and the Patent Office has not established obviousness.

Claim 10 was rejected under 35 U.S.C. § 103 as being unpatentable over Corbett and Rogers in view of Bowater et al. (hereinafter "Bowater"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection on the basis that the Patent Office has not provided the requisite actual evidence to support the combination of Corbett and Rogers, much less the combination of Corbett, Rogers, and Bowater. Absent such actual evidence, the combination is improper, and the claim is allowable.

Applicant further traverses on the basis that nothing in Bowater cures the deficiencies of the underlying combination of Corbett and Rogers. Since the references individually do not teach or suggest the claim elements, the combination of references does not teach or suggest the claim elements, and the Patent Office has not established obviousness.

Claim 11 was rejected under 35 U.S.C. § 103 as being unpatentable over Corbett and Rogers in view of Jones et al. Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses the rejection on the basis that the Patent Office has not provided the requisite actual evidence to support the combination of Corbett and Rogers, much less the combination of Corbett, Rogers, and Jones et al. Absent such actual evidence, the combination is improper, and the claim is allowable.

Applicant further traverses on the basis that nothing in Jones et al. cures the deficiencies of the underlying combination of Corbett and Rogers. Since the references individually do not teach or suggest the claim elements, the combination of references does not teach or suggest the claim elements and the Patent Office has not established obviousness.

Applicant requests reconsideration of the rejection in light of the remarks presented herein. The references of record do not teach or suggest the claimed elements, and the Patent Office has not established *prima facie* obviousness. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,
WITHROW & TERRANOVA, P.L.L.C.

By:

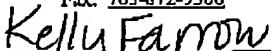


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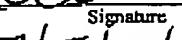
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